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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,703	03/30/2004	Ralph E. Wesinger JR.	GRAPH-005COD	8091
28661 7590 09/17/2007 SIERRA PATENT GROUP, LTD. 1657 Hwy 395, Suite 202 Minden, NV 89423			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 09/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/813,703

**Applicant(s)**

WESINGER ET AL.

**Examiner**

Naeem Haq

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-10,13-17,19-22 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-10,13-17,19-22 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/21/06; 4/19/07

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-17, 19-22, and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are directed to an "apparatus". This apparatus comprises two components: a web site and a database.

The examiner notes that a "database" is not necessarily a physical structure (c.f., a data "storage medium", such as a hard drive). A "database" in its generally accepted meaning in the computer arts is considered a "file composed of records" (see MS Press Computer Dictionary). Likewise, a "web site" is nothing more than software code. In its reasonably broad sense, the claims recite an "apparatus" that is comprised of a file and software code. Neither of these components have a physical structure to constitute an "apparatus" as claimed by the Applicants.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 13-17, 19-22, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, these claims are directed to an "apparatus". However the claims do not recite any physical structure in the body of the claims. Therefore, it is unclear to the examiner what structure the Applicants are attempting to claim.

#### ***Affidavit***

The affidavit/declaration of Ralph E. Wesinger, Jr. filed on June 28, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Montulli reference for the following reason(s):

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. (See MPEP 715.07(c) and 35 U.S.C. 104).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-5, 9, 10, 13-17, 21, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli (US 5,774,670) in view of Deaton et al. (US 5,621,812) ("Deaton") and further in view of Bly et al. (US 5,220,657)("Bly").**

Referring to claim 1: Montulli discloses a method for facilitating an online transaction comprising:

- providing a web site having an associated database (col. 4, line 50 – col. 5, line 10; Figure 1B, item “137”)
- associating, by the web site, a user ID with a user (col. 7, lines 45-55; col. 10, lines 25-30);
- presenting to the user a page, said page including an icon for invoking a process (col. 12, lines 11-27);
- clicking on said icon by the user, thereby invoking said process (col. 12, lines 28-47);
- creating a Transaction ID corresponding to said process (col. 12, lines 49-56);
- associating, by said process: customer information corresponding to said User ID; purchase information corresponding to said Transaction ID (col. 13, lines 24-30); and
- completing said process (col. 13, lines 9-23).

Montulli does not teach storing the Transaction ID in the database associated with the web site. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to relocate the Transaction ID of Montulli to the database associated with the web site, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Montulli also does not teach storing customer and information in the database. However, Deaton

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discloses a method and system for building a database for incentive marketing wherein the customer and information are stored in a database (Abstract; col.4, lines 31-46; col. 5, lines 62-65; col. 56, line 24 – col. 57, line 36; col. 64, lines 40-64). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Deaton into the invention of Montulli. One of ordinary skill in the art would have been motivated to do so in order to enable merchants to issue coupons and other inducements to customers based upon the shopping habits of the customer and to reward a high volume shoppers, as taught by Deaton (col. 64, lines 51-57). The cited prior art does not teach the process allows a user to add an entry in the database. However, Bly discloses a method that allows user to add an entry to a database (col. 28, line 64 – col. 29, line 26). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow the user to modify the database.

Referring to claim 2: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Montulli teaches that the page comprises mini homepage corresponding to said user (col. 7, lines 45-55).

Referring to claims 3 and 4: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. The cited prior art does not teach that the mini homepage includes customer information corresponding to the user, or that the customer information comprises credit card information corresponding to said user. However, the Examiner notes that these limitations are not functionally involved in the

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steps or elements of the recited or apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of method would be performed the same regardless of what information the homepage contained. The difference between the content of the Applicants' homepage and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the homepage of Montulli because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 5: The cited prior art teaches or suggests all the limitations of claim 4 as noted above. Furthermore, Montulli teaches that the online transaction is completed using the credit card information (col. 13, lines 9-23).

Referring to claims 9 and 10: The cited prior art teaches or suggests all the limitations of claim 3 as noted above. Montulli does not teach that the mini homepage includes content predefined by the user, or that said information includes an email address corresponding to said user. However, the Examiner notes that these limitations are not functionally involved in the steps or elements of the recited or apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of method would be performed the same regardless of what information the

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homepage contained. The difference between the content of the Applicants' homepage and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the homepage of Montulli because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 13 and 25: Claims 13 and 25 are rejected under the same rationale as set forth above in claim 1.

Referring to claim 14: Claim 14 is rejected under the same rationale as set forth above in claim 2.

Referring to claims 15 and 16: Claims 15 and 16 are rejected under the same rationale as set forth above in claims 3 and 4 respectively.

Referring to claim 17: Claim 17 is rejected under the same rationale as set forth above in claim 5.

Referring to claims 21 and 22: Claims 21 and 22 are rejected under the same rationale as set forth above in claims 9 and 10 respectively.

**Claims 7, 8, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli (US 5,774,670) in view of Deaton et al. (US 5,621,812)**



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**(“Deaton”) and Bly et al. (US 5,220,657)(“Bly”) and further in view of Official Notice.**

Referring to claim 7: The cited prior art teaches or suggests all the limitations of claim 3 as noted above. The cited prior art does not teach that the information may be updated by the user. However, Official Notice is taken that it is old and well known in the art for a user to update information. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an updating feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to modify his her profile.

Referring to claim 8: The cited art teaches or suggests all the limitations of claim 7 as noted above. The cited prior art does not teach that the update may only be performed receiving a proper password form the user. However, Official Notice is taken that it is old and well known in the art to allow updating only after receiving a proper password from a user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to secure a user’s personal information.

Referring to claim 19: Claim 19 is rejected under the same rationale as set forth above in claim 7.

Referring to claim 20: Claim 20 is rejected under the same rationale as set forth above in claim 8.

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**Conclusion**

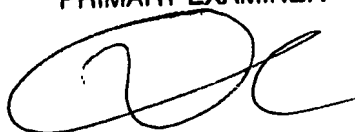
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 12, 2007

NAEEM HAQ  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Naeem Haq', written over the printed name and title.